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EXAMINER

ANTHONY, JOSEPH DAVID

ART UNIT

PAPER NUMBER

1714

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/723,878	Applicant(s) MARIA OUDE ALINK ET AL.	
	Examiner Joseph D. Anthony	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/21/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

FINAL REJECTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 6-7 and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Rose U.S. Patent Number 4,534,875 or Rose et al. U.S. Patent Number 4,880,565.

Rose teaches method for heat exchange fluids comprising viscoelastic surfactant compositions. A specifically taught viscoelastic surfactant is cetlytrimethylammonium salicylate. Applicant's claims are deemed to be anticipated over example 1.

Rose et al teaches fluorine containing viscoelastic surfactants. Applicant's claims are deemed to be anticipated over Example 1 when Sample No 1 and 2 are propelled through the metal mesh screen. The viscoelastic surfactant of Sample 1 and 2 is cetlytrimethylammonium salicylate.

It must be noted that neither Rose nor Rose et al directly disclosed that aqueous solutions of viscoelastic surfactants, such as cetyltrimethylammonium salicylate are corrosion inhibitors for metal surfaces. Nevertheless it is held that when the viscoelastic surfactants in aqueous compositions are put in contact with the metal surfaces of the apparatuses above the viscoelastic surfactants in aqueous compositions would inherently reduce/inhibit corrosion of the metal surface. It must be pointed out that all said patents disclose processes of drag reducing that are identical to applicant's

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claimed process of corrosion inhibiting. Even the disclosed concentration ranges of viscoelastic surfactants in the aqueous compositions are within applicant's claimed range. It is thus held that applicants' have not discovered a new process of use of viscoelastic surfactants in aqueous compositions, but rather has recognized that within well-known processes of using viscoelastic surfactants in aqueous compositions a side benefit of reducing corrosion on metal surfaces occurs in which they come in contact with.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rose U.S. Patent Number 4,534,875 or Rose et al. U.S. Patent Number 4,880,565.

Rose and Rose et al have been described above. They differ from applicant's claimed invention in that there is no direct teaching to the use of an aqueous fluid containing a viscoelastic surfactant such as, cetlytrimethylammonium salicylate within applicant's claimed concentration range of about 1 to about 1,000 ppm.

It would have been obvious to one having ordinary skill in the art to use the individual broad disclosure of each patent as motivation to actually use a concentration

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of viscoelastic surfactant such as, cetlytrimethylammonium salicylate, at a concentration within applicants' claimed range of about 1 to about 1,000 ppm, see Claims 10 and 15 of Rose '875.

5. Claims 6-7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teot et al. U.S. Patent Number 4,615,825 or Rose et al. U.S. Patent Number 4,806,256 or Ohlendorf et al. U.S. Patent Number 4,705,860 or Bonekamp et al. U.S. Patent Number 5,258,137.

All said patents teach the use of viscoelastic surfactants in aqueous compositions as friction or drag reduction agents. The taught viscoelastic surfactants are: cetlytrimethylammonium salicylate, and tetradecylammonium salicylate, see examples 2-3 of Teot et al.; cetlytrimethylammonium salicylate alone or used in admixture with dodecyltrimethylammonium salicylate, see example 3 of Rose et al.; n-alkyltrimethyl ammonium n-alkyl-sulfonate and hexadecyl (i.e. cetyl) trimethylammonium salicylate in examples 9 and 12-13 of Ohlendorf et al.; hexadecylammonium salicylate, tetradecylammonium salicylate, cetylpyridinium salicylate, cetlytrimethylammonium salicylate, and erucyltrimethylammonium salicylate, see examples 1-3 of Bonekamp et al..

The said patent differ from applicant's claimed invention in the following ways: 1) there is no direct statement that the viscoelastic surfactants in aqueous compositions also function as corrosion inhibitors for metals, and 2) there is no direct teaching (i.e. by

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way of an example) to actually contacting a metal surface by the disclosed viscoelastic surfactants in aqueous compositions.

It would have been obvious to one having ordinary skill in the art to use the disclosed viscoelastic surfactants in an aqueous composition in a process wherein the composition contacts a metal surface. This is obvious because all said patents individually disclose that their taught viscoelastic surfactants in aqueous compositions have many uses. One important use being in drilling fluids and other oil recover operations. It is notoriously well known in the oil drilling/recovering art that metal piping is used. It is thus held by the examiner that when the viscoelastic surfactants in aqueous compositions are pumped through these metal pipes to reduce the drag/friction of the fluids passing there through, the viscoelastic surfactants in aqueous compositions would inherently reduce/inhibit corrosion of the metal surface of the pipes. It must be pointed out that all said patents disclose processes of drag reducing that are identical to applicant's claimed process of corrosion inhibiting. Even the disclosed concentration ranges of viscoelastic surfactants in the aqueous compositions are within applicant's claimed range. It is thus held that applicant has not discovered a new process of use of viscoelastic surfactants in aqueous compositions, but rather has recognized that within well known processes of using viscoelastic surfactants in aqueous compositions a side benefit of reducing corrosion on metal surfaces occurs in which they come in contact with.

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6. Claims 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haas et al. U.S. Patent Number 4,584,109.

Haas et al. teach the use of viscoelastic surfactants in aqueous compositions as friction or drag reduction agents particular in tertiary production of crude oil. The taught viscoelastic surfactants can be selected from organic ammonium salts of the formula $R_1-N^+(R_2)(R_2'')(R_2') A^-$, wherein (R_2) and (R_2') are lower alkyl groups and (R_2'') can be a lower alkyl group or an ethoxylated group having from 1 to 3 ethoxy groups and A^- is an anion such as a salicylate group or sulfonate group, see abstract, column 2, lines 12-14, column 3, lines 35-42, and claims 2 and 7.

Haas et al. differ from applicant's claimed invention in the following ways: 1) there is no direct statement that the viscoelastic surfactants in aqueous compositions also function as corrosion inhibitors for metals, and 2) there is no direct teaching (i.e. by way of an example) to actually contacting a metal surface by the disclosed viscoelastic surfactants in aqueous compositions.

It would have been obvious to one having ordinary skill in the art to use the disclosed viscoelastic surfactants in an aqueous composition in a process wherein the composition contacts a metal surface. This is obvious because Haas et al. disclose that their taught viscoelastic surfactants in aqueous compositions have many uses. One important use being in drilling fluids and other oil recover operations. It is notoriously well known in the oil drilling/recovering art that metal piping is used. It is thus held by the examiner that when the viscoelastic surfactants in aqueous compositions are pumped through these metal pipes to reduce the drag/friction of the fluids passing there through,

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the viscoelastic surfactants in aqueous compositions would inherently reduce/inhibit corrosion of the metal surface of the pipes. It must be pointed out that Haas et al's disclose processes of drag reducing that are identical to applicant's claimed process of corrosion inhibiting. Even the disclosed concentration ranges of viscoelastic surfactants in the aqueous compositions are within applicant's claimed range. It is thus held that applicant has not discovered a new process of use of viscoelastic surfactants in aqueous compositions, but rather has recognized that within well known processes of using viscoelastic surfactants in aqueous compositions a side benefit of reducing corrosion on metal surfaces occurs in which they come in contact with.

Response to Arguments

7. Applicant's arguments filed 08/21/06 have been fully considered but are not persuasive to put the application in condition for allowance for the reasons set forth above. Additional examiner comments will be set forth next.

The restriction requirement made the examiner in the previous office action is deemed to valid for the reasons of record and is thus being made final. The examiner has dropped the previously made 35 USC 112 second paragraph indefinite issue in light of applicant's response. Applicant's argument that certain viscoelastic surfactants species, such as cetyltrimethylammonium salicylate, have been discovered by applicant to possess superior corrosion inhibiting effects as compared to other viscoelastic surfactant species such as cetyltrimethylammonium chloride (see pages 13-17 of the REMARKS section of the amendment) is noted but is deemed to be moot since the

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applied prior-art references directly teach the preferably use of cetyltrimethylammonium salicylate as a viscoelastic surfactant species.

Applicant tries to rebut the examiner's assertion that the compositions as taught and used by the applied prior art processes, would inherently function as corrosion inhibitors as well as viscoelastic compositions. Applicant's rebuttal uses certain court citations such as those found on pages 17-18 of the "Remarks" section of the amendment. Applicant states: "Where an examiner considers anticipation of an element to be inherent in a cited reference, the asserted inherency must be certain. *Ex Parte Cyba*, 144 U.S.P.Q. 756 (Board of Appeals 1966); *Ex Parte McQueen*, 123 U.S. P.Q. (Board of Appeals 1958). Inherency must be a necessary result and not merely a *possible* result. *In re Oelrich*, 666 F.2d 578, 212 U.S. P.Q. 232 (C.C.P.A. 1981); ..."

The examiner contends that such court citations are moot in regards to the factual situation in the present application because the applied prior-art references DO NOT LACK ANY ELEMENT that is contained in applicant's method of use claims. The compositions taught by the applied prior-art, and the method steps used by the applied prior-art are identical with applicant's claimed method steps. There is thus NO missing element in the applied prior-art references. The examiner asserts that applicant's claimed requirements of: "flowing the fluid under turbulent conditions ($Re > 3,000$), and to give a corrosion inhibited fluid where the corrosion inhibited fluid has improved corrosion inhibition and improved drag reduction as compared with an otherwise identical fluid absent the compound" are truly inherently met by the applied prior-art

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compositions when they are used in their disclosed method of reducing the drag of turbulent flowing fluids.

Applicant continues to argue that the applied prior-art references did not recognize the corrosion inhibiting effects of their viscoelastics surfactants such as cetyltrimethylammonium salicylate under turbulent conditions. The examiner agrees with applicant but such is a moot point in regards to the patentability of applicant's claims. What the examiner has asserted is that applicant's requirement that the compositions used in applicant's claimed methods provide a corrosion inhibiting function, is inherently met when the applied prior-art compositions are used, even though such a corrosion inhibiting property was not recognized by said prior-art. Furthermore, applicant have presented absolutely no proof that the prior-art compositions and their methods wherein metal surfaces are contacted with the compositions, will not inherently perform a corrosion inhibiting functions along with a viscoelastic function. **It is well known in patent law that the discovery of a new property in an otherwise old composition does not by itself impart patentability to the old compositions. Likewise, the discovery of a new property that occurs when an old composition is used in an old method does not impart patentability to the old method.** *Unfortunately, the provisions of 35 U.S.C. 101 do not allow a patent to be granted to applicant for the mere discovery of a new property (i.e. the corrosion inhibiting effect of certain viscoelastics surfactants such as cetyltrimethylammonium salicylate when used in aqueous compositions under turbulent conditions), since compositions containing such viscoelastics surfactants are directly taught in the above*

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applied prior-art references, and are used in methods taught by the applied prior-art references, that correspond directly to applicant's claimed method of use under turbulent conditions.

Conclusion

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Information

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The centralized FAX machine number is (571) 273-8300. All other papers received by FAX will be

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treated as Official communications and cannot be immediately handled by the Examiner.

A handwritten signature in cursive script, appearing to read "Joseph D. Anthony".

Joseph D. Anthony
Primary Patent Examiner
Art Unit 1714

11/12/06